

REMARKS/ARGUMENTS

The Office Action mailed May 31, 2005 has been reviewed and carefully considered. Claim 8 is canceled. Claim 1 has been amended. Claims 1-7 and 9-12 are pending in this application, with claim 1 being the only independent claim. Reconsideration of the above-identified application, as herein amended and in view of the following remarks, is respectfully requested.

Claims 1-7 and 9-12 stand rejected under 35 U.S.C. §103 as obvious over U.S. Patent No. 2,163,255 (Binder).

Independent claim 1 has been amended to recite "wherein an unimpeded flow connection is provided in the end of said piston rod, said flow connection being permanently open". The added phrase --permanently open-- does not require further search and consideration because it clarifies the phrase "unimpeded".

It is respectfully submitted that independent claim 1 is allowable over Binder because Binder teaches away from an unimpeded flow connection.

Binder et al. discloses a shock absorber including a piston rod extending from a cylinder, a mounting bearing through which an end of the piston rod is received, and a bellows surrounding the section of piston rod extending from the cylinder. The bellows not only protects the piston rod, but contains any damping medium leaking from the seal so that it flows back into a storage container 17 via ducts 21 and 22 (see page 2, left hand column, lines 11-15, of Binder).

A flow connection 25, 26 is provided between the interior 20 of the bellows and the atmosphere (page 2, left column, lines 19-23). This connection is provided with an equalizing device 27 having oppositely acting check valves 29, 30 (page 2, left column, lines 23-28). These valves remain closed during normal oscillations, and open only when large pressure variations

resulting from a change in load on the vehicle occur (see page 1, left column, lines 35-46). This prevents the continuous entry of contaminants which could mix with damping medium leaking through the seal and circulated back to the lower end of cylinder 14, ultimately causing the shock absorber to fail (page 1, left column, lines 49-55). The check valves also prevent damping medium from evaporating or otherwise escaping from the flow connection 25, 26 (page 1, right column, lines 1-5).

The Examiner states that it would have been obvious to one of ordinary skill in the art to omit the check valve 29, 30 to allow an uninterrupted flow. However, as described in MPEP §2141.02, a "prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)". Binder clearly teaches away from removing the check valves 29 and 30 (see page 1, left column, line 35 to page 1, right column, line 5 of Binder). Accordingly, Binder fails to provide motivation for creating an unimpeded flow connection, as recited in independent claim 1. The MPEP §2143 further states "the prior art reference (or references when combined) must teach or suggest all the claim limitations". Moreover, "[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome in which that which only the inventor taught is used against its teacher." See *W.L. Gore & Assocs. V. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Since Binder fails to disclose an unimpeded flow connection and includes a teaching against the unimpeded flow connection, it is respectfully submitted that only the present application teaches or suggest an unimpeded flow connection.

In view of the above remarks, independent claim 1 as presently amended is believed to define patentably over the art of record.

Dependent claims 2-7 and 9-12, each being dependent on independent claim 1 are deemed to be allowable for at least the same reasons as is independent claim 1.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,

COHEN, PONTANI, LIEBERMAN & PAVANE

By



Thomas C. Pontani

Reg. No. 29,763

551 Fifth Avenue, Suite 1210

New York, New York 10176

(212) 687-2770

Dated: August 25, 2005